

**IN THE UNITED STATES PATENT & TRADEMARK OFFICE**

In re Patent Application of:

<b>Wendell W. ANTHONY</b>	Confirmation No.: <b>6052</b>
Serial No.: <b>09/077,456</b>	Art Unit: <b>3684</b>
Filed: <b>May 29, 1998</b>	Examiner: <b>Susanna M. MEINECKE DIAZ</b>
For: <b>IMPROVED METHOD AND SYSTEM FOR PERFORMING BANKING TRANSACTIONS, INCLUDING HOME BANKING</b>	

**FILED ELECTRONICALLY**

United States Patent and Trademark Office  
Customer Window, Mail Stop, Appeal Brief - Patents  
Randolph Building  
Alexandria, VA 22314

**REPLY BRIEF**

Dear Sir:

This is a Reply Brief under 37 C.F.R. § 41.30 et seq. responsive to the Examiner's  
Answer mailed January 31, 2013.

**(1) Status of Claims**

Claims 1, 4, 6-30 and 33-58 are pending in this application and stand under final rejection. The rejections of claims 1, 4, 6-30 and 33-58 are hereby appealed.

**(2) Grounds of Rejection to Be Reviewed on Appeal**

A. Whether the Examiner's rejection of claims 1, 6-9, 11-14, 18, 20-30, 33-36, 38-43, 47, and 49-55 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,220,501 to Lawlor et al. ("Lawlor") in view of U.S. Patent No. 5,485,370 to Moss ("Moss") and further in view of U.S. Patent No. 5,705,798 to Tarbox ("Tarbox") is improper.

B. Whether the Examiner's rejection of claims 4, 10, and 37 under 35 U.S.C. § 103(a) as being unpatentable over Lawlor in view of Moss and Tarbox and further in view of Official Notice is improper.

C. Whether the Examiner's rejection of claims 15-17, 19, 44-46, and 48 under 35 U.S.C. § 103(a) as being unpatentable over Lawlor in view of Moss and Tarbox and further in view of Munroe, Tony. "Citibank Offers Service Link Through Computers at Home." Washington Times, Washington D.C., Section B, page 7, November 10, 1994 ("Munroe") is improper.

D. Whether the Examiner's rejection of claims 1, 30, and 57 under 35 U.S.C. § 112, second paragraph, as being indefinite is improper.

(3) Argument

A. **The Rejection of Claims 1, 6-9, 11-14, 18, 20-30, 33-36, 38-43, 47, and 49-58 under 35 U.S.C. § 103(a) Is Improper.**

Lawlor, Moss, and Tarbox, alone or in combination, fail to teach each and every element of the pending claims for at least the following reasons.

**1. End-User Installation Differs from Installation by the Host.**

The Examiner maintains that software installed by a customer is not entitled to patentable weight because a “customer” is just a label for a person. Examiner’s Answer, page 2. But even if a customer is just a label for a person, the software is installed by a person other than the host, so the limitation is still entitled to patentable weight. The method and the system are affected by where the software is installed -- at the host or by a “person” at personal computer.

The Examiner asserts that “for installation” is an intended use and not a positively recited step. This assertion appears to disregard the other terms of the claim language. For example, claim 1 recites “providing user software for installation by a customer of the business host...” As a result, to establish a *prima facie* case of obviousness, the prior art must teach that software is provided to a customer and that software has not yet been installed on the personal computer. The Examiner has not met this burden.

The Examiner also asserts that a human cannot be a limiting element of an apparatus, citing MPEP 2105. The MPEP explains that if a claimed invention as a whole encompasses a human organism, then it is not patent-eligible subject matter under 35 U.S.C. § 101. The pending claims are not directed to a human organism, as discussed in MPEP 2015. Instead, the claims recite how a component is installed by a customer rather than at a business host. If the Examiner believes that these claims as a whole are directed to a human organism, then a rejection under 35 U.S.C. § 101 would have been appropriate.

The combination of Lawlor with Moss does not teach user software for installation by a customer of the business host on the home banking terminal. Lawlor recites that no hardware or installation expense is required for the devices. Col. 8, lines 6-19; col. 20, lines 7-10. Moss recites that programs are retained on the host computer so that they do not have to be downloaded to the home terminal. Col. 18, lines 6-17. So Lawlor and Moss actually teach against such a limitation. Tarbox uses already-installed applications on an ATM, so Tarbox also does not teach such a limitation.

**2. A Personal Computer Is Not an ATM.**

The Examiner maintains that an ATM is the same as a personal computer. The Examiner asserts that the personal computer capabilities are not the subject of the claimed invention. However, the claims recite, e.g., “the installed user software enables the personal computer to allow multiple customers of the business host to each select from different languages and enables the computer to access the infrastructure and business software located on the server,” as recited in claim 1. The claims also recite both an ATM and a personal computer. In both method claims and system claims, it is not clear how the Examiner can assert that Lawlor’s ATM can teach both claimed elements.

The Examiner asserts that Lawlor’s ATM is “more akin to terminals that remotely provide typical ATM functionality.” While Lawlor has highlighted the disadvantages to using a personal computer, see, e.g., cols. 1 and 2, Lawlor recites an ATM-like terminal that “is designed to interact with users in a manner similar to ATM user interaction.” Col. 8, lines 18-19. Thus, the ATM in Lawlor is actually more like an ATM than a personal computer, in direct contrast to what the Examiner asserts.

The Examiner also asserts that Lawlor “improves upon previous uses of personal computers” rather than teach away from them. As discussed throughout Lawlor, personal computers required special software to be installed, and as a result, were failures and discontinued for the purposes of home banking. Accordingly, Lawlor offered a different product that did not resemble a customer’s personal computer. A personal computer is widely considered a general purpose computer, and the pending claims recite the use of software installed on this computer to make it a specially-programmed personal computer. In contrast, Lawlor’s product resembles an ATM, whereby it is pre-programmed and is not a general purpose computer.

The cited references merely discuss ATMs or limited functionality terminals, but none of the references teach the use of a personal computer that can be configured as a home banking terminal.

**3. The Claimed Software Enables Different Language Selection.**

The Examiner maintains that the cited references teach installed user software enables the personal computer to allow multiple customers of the business host to each select from different languages. In support of this argument, the Examiner does not establish that any of the cited references actually recite this feature. Instead, the Examiner asserts that such a feature would be beneficial and “[e]ach reference contributes elements to make a transaction more convenient for a user.”

The Examiner asserts that Appellant’s arguments are against the references individually, but then cites to Tarbox for an alleged teaching. Tarbox recites a card that stores preferences, and the card is used with an ATM. So Tarbox cannot teach a personal computer that is programmed to allow multiple users to select different languages. Further, Tarbox issues a card to each user, so each user’s card stores the user’s preferences. In contrast, the pending claims recite allowing “multiple users of the remote terminal to each select from different languages when accessing the remote terminal.” Tarbox does not recite that its ATM or its card can provide this functionality.

**B. The Rejection of Claims 4, 10, and 37 under 35 U.S.C. § 103(a) Is Improper.**

The Examiner maintains these rejections in view of the previous arguments. However, the Examiner does not address the deficiencies in the alleged teaching of Applicant’s admitted prior art, which fails to remedy the shortfalls of Lawlor, Moss, and Tarbox.

**C. The Rejection of claims 15-17, 19, 44-46, and 48 under 35 U.S.C. § 103(a) as being unpatentable over Lawlor in view of Moss and Tarbox and further in view of Munroe is improper.**

The Examiner maintains this rejection in view of arguments presented in Section A, and the response in Section A is incorporated herein.

**D. The Rejection of Claims 1, 30, and 57 under 35 U.S.C. § 112 Is Improper.**

The Examiner maintains this rejection because “installation” is considered an intended use, so “providing user software for installation” does not provide antecedent basis for “the installed user software.” It is evident that “installed user software” is the same software earlier recited in “providing user software for installation.” This antecedent basis is explicitly present,

but at the very least, is present by implication and reasonably ascertainable. *See, e.g., Haliburton Energy Services, Inc. v. M-I LLC*, 514 F.3d 1244 (Fed. Cir. 2008) (citing *Energizer Holdings, Inc. v. Int’l Trade Comm’n*, 435 F.3d 1366, 1370-71 (Fed. Cir. 2006)). These terms are not indefinite because it is clear that the installed user software is the user software provided for installation.

If “installation” is considered an intended use and disregarded from the claim language, then the antecedent basis is even more clear. The claim would read “providing user software” and then recite “user software,” without any question as to whether the user software is the same.

**CONCLUSION**

The undersigned representative respectfully submits that this application is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that the prosecution might be advanced by discussing the application with the undersigned representative, in person or over the telephone, we welcome the opportunity to do so. In addition, if any additional fees are required in connection with the filing of this response, the Commissioner is hereby authorized to charge the same to Deposit Account 19-3140.

Dated: March 29, 2013

Respectfully submitted,

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